

REMARKS

This paper is filed in response to the office action mailed on July 28, 2005. Claims 2-16, 18, 23-28, 40-51, 53-56, 58-63, 65-68 and 70 have been at least temporarily withdrawn from consideration; claims 1, 17, 19-22, 39, 52, 57, 64 and 69 stand rejected; no claims have been amended; claims 1, 17, 19-22, 39, 52, 57, 64 and 69 are pending and under consideration.

With respect to the rejection based upon the prior art, pending claims 1, 17, 19-22, 39, 52, 57, 64 and 69 all stand rejected under 35 USC § 102(e) as being anticipated by U.S. Patent No. 6,579,246 ("Jacobsen").

Applicants respectfully submit that this anticipation rejection fails to meet the criteria set forth by the MPEP and the relevant case law. Under MPEP § 2131,

[t]o anticipate a claim, the reference must teach every element of the claim. 'A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.'

Citing, Verdegaaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Jacobsen is directed to a guidewire system. The Patent Office relies upon Figs. 2-7 and 13-18 of Jacobsen in rejecting the claims under consideration. However, Figs. 1-7 are all directed to various *solid* guidewires. *See Jacobsen*, at col. 4, line 41 ("a solid guidewire 200"), col. 6, lines 43-44 ("a solid guidewire 260"), col. 6, line 61 ("a solid guidewire 270"), col. 7, line 23 ("a solid guidewire 284"), and col. 7, line 23 ("a solid guidewire 300"). Figs. 13-18 of Jacobsen all describe a generally solid "core" guidewire 500 with the only tubular element of the guidewire being the micromachined tubing 514 that is attached at a distal end or tip 511. *See Fig. 18.*

Independent claims 1, 20, 52 and 64 are not directed to a solid guidewire or a core guidewire. Instead, these claims are all directed to a hypotube, which is used at a proximal end of a catheter to help guide the catheter in the vasculature system. The claimed hypotubes provide an improved transition in terms of pushability and trackability between the hypotube and the proximal end of the catheter and, more specifically, between the distal end of the hypotube and the proximal end of the catheter. *See the present application at page 3, lines 6-18.*

Each independent claim 1, 20, 52 and 64 recites a hypotube comprising a tubular shaft with a tubular wall that defines a lumen and a main section connected to a distal section. Jacobsen does not teach or suggest a hypotube, or a tubular shaft with a tubular wall that defines a lumen. Each independent claim also recites a slit disposed in a tubular wall of the distal section of the hypotube that includes a stinger formed from the tubular wall.

Claim 1 recites a slit in the tubular wall of first section of the distal section with the first section being disposed between the stinger and the main section. Claim 1 also recites that the stinger is formed from the tubular wall. The only tubular member taught in Jacobsen is the tubular member 514 and, while it includes slits, it does not include a stinger next to a slit as recited in claim 1 or a stinger formed from a tubular wall as recited in claim 1. The only stinger taught by Jacobsen is the distal end 510 of the solid core guidewire 501 (Fig. 14) which is then covered by the separate micromachined member 514. Jacobsen does not teach a tubular member with a slit disposed in a distal section of the tubular wall next to a stinger that is formed from the tubular wall as recited in claim 1.

Like claim 1, claim 20 recites a hypotube with a slit in the tubular wall of first section of the distal section with the first section being integrally connected to the tubular main section and disposed between the stinger and the main section. Claim 20 also recites that the stinger is formed from a portion of the tubular wall of the distal section. Jacobsen does not teach a tubular member with a slit disposed in a distal section of the tubular wall next to a stinger that is formed from a portion of the tubular wall as recited in claim 20.

Similar to claims 1 and 20, claim 52 recites a hypotube with a slit in the tubular wall of distal section with the slit being disposed next to a stinger that is formed from an elongated cut-out of the tubular wall of the distal section. Jacobsen does not teach a tubular member with a slit disposed in a distal section of the tubular wall next to a stinger that is formed from an elongate cut-out of the tubular wall as recited in claim 52.

Similar to claims 1, 20 and 52, claim 64 recites a hypotube with a slit in the tubular wall of distal section with the slit being disposed next to a stinger that is part of the tubular wall of distal section of the hypotube. Jacobsen does not teach a tubular member with a slit disposed next to a stinger that is part of a tubular wall of a distal section of a hypotube as recited in claim 52.



Application No.: 10/034,448

Docket No.: 29985/01-180

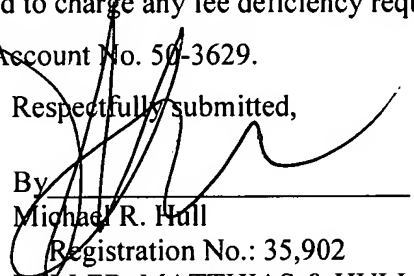
Jacobsen is directed to a solid guidewire, with modifications to the guidewire to make it work better *within* a catheter (*see* Fig. 12d). The Jacobsen guidewire is not intended to engage a proximal end of a catheter like the claimed hypotube. As noted above, it is completely missing numerous elements of each independent claim. Therefore, Jacobsen cannot serve as an anticipating reference and the anticipation rejection of claims 1, 17, 19-22, 39, 52, 57, 64 and 69 is improper and should be withdrawn.

With all prior art rejections having been traversed, applicant respectfully submit that this application is in a condition for allowance in an early action, so indicating is respectfully requested. Applicant also respectfully re-solicits the reconsideration of all withdrawn dependent apparatus claims for the reasons set forth in the papers dated August 9, 2004 and December 2, 2004.

The Commissioner is authorized to charge any fee deficiency required by this paper, or credit any overpayment, to Deposit Account No. 50-3629.

Dated: October 25, 2005

Respectfully submitted,

By 
Michael R. Hull
Registration No.: 35,902
MILLER, MATTHIAS & HULL
One North Franklin Street
Suite 2350
Chicago, Illinois 60606
(312) 977-9902, ext. 203
Attorney for Applicant